

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of

NAKAI et al.

Atty. Ref.: 1275-44

Serial No. 09/833,651

TC/A.U.: 2173

Filed: April 13, 2001

Examiner: Pillai, Namitha

For: PRINT CONTROL OPERATION SYSTEM USING ICONS

May 19, 2005

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Applicant hereby appeals to the Board of Patent Appeals and Interferences from
the last decision of the Examiner.

REAL PARTY IN INTEREST

The real party in interest is Sharp Kabushiki Kaisha, a corporation of the country
of Japan.

RELATED PROCEEDINGS

The appellant, the undersigned, and the assignee are not aware of any related
appeals, interferences, or judicial proceedings (past or present), which will directly affect
or be directly affected by or have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

Claims 1-10 are pending and have been rejected. No claims have been substantively allowed. Thus, claims 1-10 are on appeal.

STATUS OF AMENDMENTS

No amendments have been filed since the date of the Final Rejection. However, the Response After Final filed July 6, 2004 has been considered as evidenced by the Advisory Action dated August 24, 2004.

SUMMARY OF CLAIMED SUBJECT MATTER

For purposes of example and without limitation, certain example embodiments of this invention relate to a print control operation system. The system uses icons including a display picture for displaying a print icon 11 having predetermined print conditions and a file icon 12, 15 of a file to be printed (e.g., see Figs. 3A, 4A, 5, 6, 7, etc.).

Print processing is executed under predetermined print conditions in the print icon by dragging the file icon (e.g., 12) and dropping the file icon on the print icon 11. Moreover, the print icon 11 is formed so that the display is altered according to a setting of the print conditions in the print icon, and the print conditions are displayed on the display picture in a recognizable display form without having to locate the file icon on the print icon (e.g., pg. 11, lines 9-24). Since print conditions may be displayed in accordance with a shape of a printer icon, when a document file is made dragging and dropping onto a printer icon, the printing conditions can be recognized without a

particular operation such as hovering so that efficiency and convenience can be significantly improved in certain example embodiments of this invention.

Claim 3 requires that, at a time point when a file icon of a file to be printed is superposed on said print icon, a printing preview of the file icon is displayed on said display picture. As an example, referring to the specification, in certain example embodiments of this invention, at a time point when a file icon 12, 15 of a file to be printed is superposed on the print icon 11, a printing preview of the file icon is displayed on said display picture. For example, see the instant specification at pg. 4, lines 20-25; pg. 18, lines 9-15; and Figs. 7 and 11. As shown in Figs. 7 and 11, a "printing preview" is an image of at least part of what is going to be printed. This is advantageous, for example, in that it permits a user to view and confirm contents of a file to be printed without having to open the file on an application (e.g., pg. 18, lines 12-15).

Claim 9 requires that "said print control operation system is formed so as to create a print icon having new print conditions set therein, when a predetermined plurality of print icons displayed on said display screen and respectively having different print conditions are coupled." In other words, a new printing icon is created by coupling a plurality of previous or other print icons that were displayed. For example, and without limitation, Fig. 10 illustrates that a new printing icon 312 having both multi-shot and stapling functions is created when a previous printing icon 32 having stapling is dragged and dropped on a previous print icon 31 having multi-shot (e.g., pg. 16, line 22 to pg. 17, line 16).

Claim 1 requires that "the print icon is formed so that the display is altered according to a setting of the print conditions in said print icon, and said print conditions

are displayed on said display picture in a *recognizable display form* without having to locate the file icon on the print icon." In certain example embodiments, print processing is executed under predetermined print conditions in the print icon by dragging the file icon (e.g., 12) and dropping the file icon on the print icon 11. In certain example embodiments, the print icon 11 is formed so that the display is altered according to a setting of the print conditions in the print icon, and the print conditions are displayed on the display picture in a recognizable display form without having to locate the file icon on the print icon (e.g., pg. 11, lines 9-24). Since print conditions may be displayed in accordance with a shape of a printer icon, when a document file is made dragging and dropping onto a printer icon, the printing conditions can be recognized without a particular operation such as hovering so that efficiency and convenience can be significantly improved in certain example embodiments of this invention.

Claim 8 requires "a printer to be used is set in said print icon as one of set conditions of said print icon, a state of said printer is monitored in said print control operation system, and *when said printer is in such a state that said printer cannot execute processing set in said print icon, said print icon is controlled so as not to be displayed.*" For example, see the instant specification at page 19, line 19 to page 20, line 1. See also page 16, lines 5-15. For example, it is explained on page 16 of the instant specification that "[i]n this case, however, the state of a printer set in each print icon is confirmed, and a print icon of a printer that cannot conduct processing is prevented from being displayed. For example, if staple processing is set in a print icon and the set printer staple runs out, then the print icon is not displayed. Also in the case where the power supply of a set printer is not on, the print icon is not displayed. Or it is also possible to conduct gray-out

display of a print icon that cannot be processed and explicitly indicate that the function is inhibited.”

ISSUES (GROUNDS OF REJECTION)

1. Claim 3 stands rejected under 35 U.S.C. Section 102(b) as being allegedly anticipated by Fitzpatrick (US 5,546,527).
2. Claims 1-2 and 4-10 stand rejected under 35 U.S.C. Section 103(a) as being allegedly unpatentable over Fitzpatrick in view of Hemenway (US 5,638,505).

ARGUMENTS

It is axiomatic that in order for a reference to anticipate a claim, it must disclose, teach or suggest each and every feature recited in the claim. See, e.g., Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). The USPTO has the burden in this respect.

Moreover, the USPTO has the burden under 35 U.S.C. Section 103 of establishing a *prima facie* case of obviousness. In re Piasecki, 745, F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). It can satisfy this burden only by showing that some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Before the USPTO may combine the disclosures of the references in order to establish a *prima facie* case of obviousness, there must be some suggestion for doing so. In re Jones, 958 F.2d 347 (Fed. Cir. 1992). Even

assuming, *arguendo*, that a given combination of references is proper, the combination of references must in any event disclose the features of the claimed invention in order to render it obvious.

Claim 3

Claim 3 stands rejected under 35 U.S.C. Section 102(b) as being allegedly anticipated by Fitzpatrick (US 5,546,527). This Section 102(b) rejection should be reversed for at least the following reasons.

Claim 3 requires that "at a time point when a file icon of a file to be printed is superposed on said print icon, a printing preview of the file icon is displayed on said display picture." For example, see the instant specification at pg. 4, lines 20-25; pg. 18, lines 9-15; and Figs. 7 and 11. As shown in Figs. 7 and 11, a "printing preview" as called for in claim 3 is an image of at least part of what is going to be printed. This is advantageous, for example, in that it permits a user to view and confirm contents of a file to be printed without having to open the file on an application (e.g., pg. 18, lines 12-15).

Fitzpatrick fails to disclose or suggest the aforesaid aspect of claim 3. A "printing preview" as called for in claim 3 is an image of at least part of what is going to be printed as shown in Figs. 7 and 11. Fitzpatrick does not display such a printing preview of the file icon when the file icon is superposed on the print icon. There is absolutely nothing in Fitzpatrick even remotely related to this aspect of claim 3. The cited art is entirely unrelated to the invention of claim 3, and the Section 102(b) rejection should be reversed for at least this reason.

Claim 9

Claim 9 stands rejected under 35 U.S.C. Section 103(a) as being allegedly unpatentable over Fitzpatrick and Hemenway. This Section 103(a) rejection should be reversed for at least the following reasons.

Claim 9 requires that "said print control operation system is formed so as to create a print icon having new print conditions set therein, when a predetermined plurality of print icons displayed on said display screen and respectively having different print conditions are coupled." In other words, a new printing icon is created by coupling a plurality of previous or other print icons that were displayed. For example, and without limitation, the instant specification explains that a new printing icon having both multi-shot and stapling functions is created when a previous printing icon having stapling is dragged and dropped on a previous print icon having multi-shot (e.g., pg. 16, line 22 to pg. 17, line 16).

Fitzpatrick fails to disclose or suggest this aspect of claim 9. In particular, the cited art fails to disclose or suggest coupling a plurality of different printer icons in order to create a new printer icon. The Examiner's contention that this is "inherent" on page 7 of the final Office Action is clearly incorrect and unsupported. Fitzpatrick is entirely unrelated to the invention of claim 9 in this respect, and discloses nothing relating thereto.

Moreover, there is no suggestion present in the art of record which would have led one of ordinary skill in the art to have modified Fitzpatrick to meet this aspect of claim 9. There is certainly no *prima facie* case of obviousness in this respect.

Claim 1

Claim 1 stands rejected under 35 U.S.C. Section 103(a) as being allegedly unpatentable over Fitzpatrick and Hemenway. This Section 103(a) rejection should be reversed for at least the following reasons.

Claim 1 requires that "the print icon is formed so that the display is altered according to a setting of the print conditions in said print icon, and said print conditions are displayed on said display picture in a recognizable display form without having to locate the file icon on the print icon." Since print conditions may be displayed in accordance with a shape of a printer icon, when a document file is made dragging and dropping onto a printer icon, the printing conditions can be recognized without a particular operation such as hovering so that efficiency and convenience can be significantly improved in certain example embodiments of this invention. The cited art fails to disclose or suggest the aforesaid underlined aspect of claim 1.

Fitzpatrick discloses that a dragged document icon is hovered over a print icon for a few seconds. By continued hovering of the document icon over/on the print icon, a dialog box for altering print conditions is displayed. Thus, Fitzpatrick discloses that print conditions are displayed when a certain operation is made on a printer icon, but that print conditions cannot be recognized unless the operation is carried out. In particular, in Fitzpatrick print conditions are displayed *only* when such hovering over/on the print icon is performed. Accordingly, it can be seen that Fitzpatrick *fails* to disclose or suggest that "print conditions are displayed on said display picture in a *recognizable display form without having to locate the file icon on the print icon*" as required by claim 1. Instead,

Fitzpatrick teaches directly away from this aspect of claim 1 and cannot render the same unpatentable.

Hemenway also fails to disclose or suggest that "print conditions are displayed on said display picture in a *recognizable display form* without having to locate the file icon on the print icon" as required by claim 1. Hemenway discloses that print conditions are displayed on a different window; hence it is very inconvenient for recognizing when dragging and dropping is carried out. Since both cited references fail to disclose or suggest at least the "recognizable display form" aspect of claim 1, then even the alleged combination (which is incorrect in any event) fails to meet the invention of claim 1. With this claimed feature, it advantageously becomes possible in certain example embodiments for an operator to easily recognize the print condition without performing any specific operation.

Accordingly, even the alleged combination fails to disclose or suggest the invention of claim 1. Moreover, there is no suggestion in the art of record for the alleged combination, and there is certainly no suggestion in the art of record which would have led one of ordinary skill in the art to have modified the base reference to Fitzpatrick in a manner which would meet claim 1. Instead, Fitzpatrick teaches directly away from the invention of claim 1 since in Fitzpatrick print conditions are displayed *only* when such hovering over/on the print icon is performed (which is the opposite of what claim 1 requires).

Claim 8

Claim 8 requires "a printer to be used is set in said print icon as one of set conditions of said print icon, a state of said printer is monitored in said print control

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operation system, and *when said printer is in such a state that said printer cannot execute processing set in said print icon, said print icon is controlled so as not to be displayed.*"

Again, the cited art fails to disclose or suggest this aspect of claim 8. There is nothing in the art of record which would have led one of ordinary skill to the invention of claim 8.

There is clearly no prima facie case of obviousness in this respect.

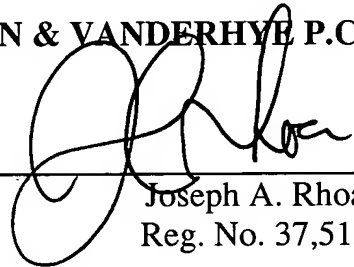
CONCLUSION

In conclusion it is believed that the application is in clear condition for allowance; therefore, early reversal of the Final Rejection and passage of the subject application to issue are earnestly solicited.

Respectfully submitted,

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APPENDIX
CLAIMS ON APPEAL

1. A print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of said file being executed under the predetermined print conditions in said print icon by dragging said file icon and dropping said file icon on said print icon,

wherein the print icon is formed so that the display is altered according to a setting of the print conditions in said print icon, and said print conditions are displayed on said display picture in a recognizable display form without having to locate the file icon on the print icon.

2. A print control operation system using icons according to claim 1, wherein at a time point when a file icon of a file to be printed is superposed on said print icon, an outline of the print conditions preset in said print icon is displayed on said display picture.

3. A print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of said file being executed under the predetermined print conditions in said print icon by dragging said file icon and dropping said file icon on said print icon,

wherein the print conditions in said print icon are displayed on said display picture in a recognizable display form, and

wherein at a time point when a file icon of a file to be printed is superposed on said print icon, a printing preview of the file icon is displayed on said display picture.

4. A print control operation system using icons according to claim 1, wherein when a plurality of file icons of files to be printed are dragged and dropped on said print icon, these files are consecutively subject to print processing as a series of recorded matters.

5. A print control operation system using icons according to claim 1, wherein when a file icon of a file to be printed is dragged and dropped on said print icon, a window for setting print conditions of said print icon is opened.

6. A print control operation system using icons according to claim 1, wherein when a file icon is dragged and dropped on said print icon, a printer capable of conducting print processing is automatically selected based on print conditions set in said print icon.

7. A print control operation system using icons according to claim 6, wherein when a file icon is dragged and dropped on said print icon, a printer capable of conducting print processing is automatically selected from among printers in a stand-by state, based on print conditions set in said print icon.

8. A print control operation system using icons according to claim 6, wherein a printer to be used is set in said print icon as one of set conditions of said print icon,

a state of said printer is monitored in said print control operation system, and

when said printer is in such a state that said printer cannot execute processing set in said print icon, said print icon is controlled so as not to be displayed.

9. A print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of said file being executed under the print conditions predetermined in said print icon by dragging said file icon and dropping said file icon on said print icon,

wherein said print control operation system is formed so as to create a print icon having new print conditions set therein, when a predetermined plurality of print icons displayed on said display screen and respectively having different print conditions are coupled.

10. A print control operation system using icons according to claim 1, wherein at a time point when a file icon of a file to be printed is superposed on said print icon, a printing preview of the file icon is displayed on said display picture.